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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,860	06/09/2001	George Michael Mockry	530.005PA	8653

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EXAMINER	
CHAMBERS, MICHAEL S	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,860	MOCKRY ET AL.	
	Examiner	Art Unit	
	Mike Chambers	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Re-open Prosecution

Applicant is advised that the Notice of Allowance mailed 2/24/04 is vacated.

Prosecution on the merits of this application is reopened on claims 23-34 are considered unpatentable for the reasons indicated below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23-34 are rejected under 35 U.S.C. 103(a) as obvious over SeasonTicket in view of Rangan et al. SeasonTicket discloses recording personalized sport video highlight shows (page2 2nd paragraph). The duration and subject matter recorded is a matter of design choice to the viewer. The specification provides no unexpected results in recording the action plays of the game. The content of an edited video contains no patenable novelty. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited and recorded the video to reflect what the viewer wished to record based on personal preferences. This requires no patentable skill. The method claimed would naturally be used when the video was produced and played. Although SeasonTicket makes reference to the fact that video highlights were pre-selected by the user, which one may infer the user was a subscriber, it is not clear(Note the second reference for season ticket, notes in the 6th paragraph that the video highlights were pre-selected by the user

which would indicate there was a subscription service). Rangan et al discloses the use of subscribers is well known in the art (5:50-64,23:32-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to included obtaining subscribers in order to increase the profitability of the business.

As to claim 24: See claim 23 rejection. The decisions to record each appearance at bat for every player, the final pitch thrown to each player and successful and unsuccessful attempts by the base runners are design choices based on editing decisions by the editor. The specification provides no unexpected results in recording the action plays of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences. The method claimed would naturally be used when the video was produced and played.

As to claim 25: No criticality is seen in the duration of the edited recording. The duration of the edited recording is a matter of design choice. The specification provides no unexpected results in using a edited recording of 15 minutes. It would have been obvious to one of ordinary skill in the art to have selected an appropriate length of time for the video to run based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 26: No criticality is seen in the portion of the game recorded. The portion of the game recorded is a matter of design choice. The specification provides no unexpected results for recording a portion of a nine-inning baseball game. It would have been obvious to one of ordinary skill in the art to have selected an appropriate portion of

the game to record and show based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 27: Seasonticket discloses broadcasting over the internet (page1 3rd paragraph). See also Rangan et al as applied above.

As to claim 28: The method claimed would occur naturally when the video tape was played. It would have been obvious to one of ordinary skill in the art to have included the method of playing the video tape since this is one of the logical reasons for producing the video. The method claimed would naturally be used when the video was produced and played. There is no patentable novelty in broadcasting a video. The means for display is a matter of design choice. The specification provides no unanticipated results from the various means of display chosen.

As to claim 29: Seasonticket discloses audio commentary (page2 3rd paragraph). No criticality is seen in the audio containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claim 30: See claim 25 rejection.

As to claim 31: See claim 26 rejection.

As to claim 32: See claim 27 rejection.

As to claim 33: See claim 28 rejection.

As to claim 34: See claim 29 rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-15 of copending Application No. 10/858470 in view of Rangan et al Rangan et al discloses the use of subscribers is well known in the art (5:50-64,23:32-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to included obtaining subscribers in order to increase the profitability of the business.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The method claimed in this application merely takes a well known procedure (editing tapes) and applies the end result of the editing process to a subscription

service. Although it may be argued that there should also be a 101 rejection since it is questionable whether or not the claimed invention falls in the technological arts, the decision at this point in time is to reject the claims on the art cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers
Examiner
Art Unit 3711

February 27, 2005

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700